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EXAMINER

REICHLE, KARIN M

ART UNIT PAPER NUMBER

3761

DATE MAILED: 01/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

HCT

# Office Action Summary

Applicant(s)

09/892,900

Applicant(s)

RAKE ET AL.

Examiner

Karin M. Reichle

Art Unit

3761

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 06 November 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 14-27 is/are pending in the application.
- 4a) Of the above claim(s) 18, 20-22 and 25-27 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 14-17, 19, 23 and 24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 June 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Art Unit: 3761

1. Applicant's election without traverse of the species of Figures 52-55 in Paper No. 7 is acknowledged.
2. Claims 18, 20-22 and 25-27 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made without traverse in Paper No. 7. Claims 20-22 and 25-27 have been withdrawn in addition to claim 18 because they do not read on the elected species. These claims require two springs in addition to a parallelogram linkage assembly, i.e. at least four springs, whereas the elected species has only the parallelogram linkage assembly which assembly has two springs.

The election requirement made in Paper No.6 is deemed proper and made FINAL.

3. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

For example:

4. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 120 as follows:

This application is claiming the benefit of a prior filed nonprovisional application under 35 U.S.C. 120, 121, or 365(c). Copendency between the current application and the prior application is required.

Art Unit: 3761

Copendency between the parent application 08/876,180, filed 6-23-97, and the grandparent application 07/898,958, abandoned 2-06-95, and thereby any application in the line before that application, i.e. the greatgrandparent application 07/824,855, does not exist. Therefore the oldest effective filing date of the instant application is that of 08/876,180 or 6-23-97.

5. This application appears to be a division of Application No. 08/876,180, filed 6-23-97, rather than a continuation since the invention in the parent case was a flexible, compressible medication container and the invention in this application is an infusion pump. A later application for a distinct or independent invention, carved out of a pending application and disclosing and claiming only subject matter disclosed in an earlier or parent application is known as a divisional application or "division." The divisional application should set forth only that portion of the earlier disclosure which is germane to the invention as claimed in the divisional application.

6. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

The following title is suggested: PLATEN PUMP or PLATEN PUMP WITH PARALLELOGRAM LINKAGE.

7. The abstract of the disclosure is objected to because terminology which can be inferred, i.e. "Disclosed is", "are also disclosed", and legal terminology, i.e. "comprises", should be avoided. Correction is required. See MPEP § 608.01(b).

Art Unit: 3761

8. The prior art cited in the specification has been noted but will not appear on the front of a patent, if any, unless cited on any PTO-892 or -1449 which accompanies this Office action, since such citations do not comply with 37 CFR 1.56, 1.97 and 1.98.

9. The drawings are objected to because the axes of the graphs in Figures 56-60 are either not clearly marked or not marked as set forth on page 7, lines 26-32. Note also page 53, line 30- page 54, line 24 and page 39, lines 3-8. In Figure 4, the line from 23 should extend to the structure it denotes. In Figure 8b, the line from 114 should extend to the structure it denotes. Also, numeral 117 should denote the chamber not the bag. In Figure 8a, 124 seems to denote the structure 136 not the platen as described. In Figure 10, the line from 186 should clearly extend to the flange. In Figure 25, the line from 263 should extend to the flange of 260. In Figure 29, the lines from 366 and 364 should be dashed to denote underlying structure. This also applies to the lines from 364 in Figure 48, the line from 368 in Figure 50, the line from 411 in Figure 52, and the lines from 438 in Figure 53 and Figure 54. There is an undenoted line in Figures 51 and 39. In Figure 53, the lines from 412 and 412' should clearly denote the springs. In Figures 53 and 54, the structure 421 should be clearly denoted. The level indicator mounted in a track as described on page 51, lines 18-21 should be clearly shown in Figure 54. In Figures 50 and 51, the left 370 should be 372 to be consistent with the description. In Figures 60-69, where is 572? A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Art Unit: 3761

10. The formal drawings filed 10-18-01 have been placed in the file but are not approved by the Examiner because the Figures are not the same as those originally filed and were not accompanied by proposed Figures showing the changes in red ink, e.g. in Figure 34 the double headed arrow has been labeled. See also discussion of Figures *supra* and *infra*.

11. The disclosure is objected to because of the following informalities: 1) The Summary of the Invention section, i.e. a description of the claimed invention, and the invention of the claims should be commensurate, see MPEP 608.01(d) and 1302.01. 2) Also, on page 1, lines 7-8 appear to be noncommensurate with the claims and, e.g., page 9, lines 20-21. 3) On page 3, last line, "devices" should be --device-- 4) The description of Figures 8a and 8b on page 4 are incomplete, i.e. they are only partial cross sections. The descriptions of Figures 35-36, and 42-43 are also incomplete, i.e. they are cross sectional views. Note the similar descriptions on page 34, lines 3 and 26-27 are also incomplete. The description of Figure 10 also appears to be incomplete, i.e. is it along the line 10-10 in Figure 9? In Figure 34, what is the arrow ended line through the pump? What is the arrow ended line in Figure 46? Figure 52? What are the phantom lines in Figures 66, 70, 74, 78, 82, 84, 86, 88? 5) On page 16, line 35, "188" should be --118-- 6) Reference to the inventors on page 20, line 29 and page 38, line 30 should be avoided, i.e. the description should be of the invention. 7) In Figure 16, what is 216? The same numeral is also used to denote different structure in Figures 18-20. A numeral should only be used to denote the same structure. 8) The description on page 24, lines 7-9 and Figures 18-20 are not consistent, i.e. where does the lever extend beyond the periphery of the housing? 9) On page 31, line 27, after "288", --, shown

Art Unit: 3761

in phantom,-- should be set forth. On page 39, line 29, "342" should be --344--. 10) Are "allen wrench"(page 32, line 27) and "Delrin"(page 50, line 7 and page 52, line 27) trademarks? If so they should be properly denoted as such, e.g. all capital letters. 11) The description on page 50, lines 17-18, i.e. "each", is inconsistent with the Figures 52-55. 12) What is 550 in Figure 65? 13) Page 12, lines 19-21 appear to be missing a word or words? 14) The description of Figures 8-8b and page 16, lines 32-33 appear to be inconsistent, i.e. nonsimilar structure has not been denoted differently. 15) On page 44, line 31, "angels" should be --angles--. 16) On page 46, line 6, "segment" should be deleted.

Appropriate correction is required.

12. Claims 23-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A positive structural antecedent basis for "said at least one spring"(claim 23, line 9) should be defined.

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section

Art Unit: 3761

- 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or  
(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).
14. Claims 14-17, 19 and 23-24 are rejected under 35 U.S.C. 102(e) as being anticipated by

Rake et al , '716.

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e).

This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR

1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

See elements 12, 16, 24, 40, 42, 17, 18, 14, 13, 19 in Figures 1-4 and claims , especially last section of claims 1, 3 and 4, of Rake et al.

15. Claims 14-17, 19 and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Bessesen.

See Figure 1, 1 and 3 are threadably engaged shells of generally circular outer shape, platen is 7 with nonplanar surface 9 which is complementary to inner surface of shell 1 adjacent 2, 14 is a spring fastened to shell 3. With regard to the language of lines 1, 6-7, i.e. "said space...therein", and last three lines of claim 1, similar language in claim 19 and 23 and line 1 of claim 23, such language recites function, properties or capabilities of the structure recited in the claim. Since the Bessesen patent also includes such claimed structure, such properties , functions



Art Unit: 3761

and capabilities are also presumed inherent in the same structure of Bessesen. See MPEP

2112.01.

16. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103© and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 14-15, 17, 19 and 23-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over May '123 in view of Dorman et al '263 and Jassawalla et al '018 .

In regard to claims 14-15, 19 and 23-24, the May device, see , e.g., Figures 1-2, col. 4, lines 4-6, and col. 3, lines 56-60, includes a first shell 24, a second shell 11, a platen 15, a space 12 holding a fluid delivery bag 68 connected to an outlet tube 74 and springs 16 attached to both the platen and second shell. Also note col. 2, lines 7-10, col. 6, lines 34-41, col. 7, lines 58-65

Art Unit: 3761

and col. 8, lines 42-57. The May pump includes all the claimed structure and function except for the first shell having a nonplanar interior surface and the platen defining a surface complementary thereto. However, see the pump of Dorman et al at Figure 6 and col. 7, line 60-col. 8, line 2, and the pump of Jassawalla et al at Figure 2 and col. 4, lines 40-47. To make include complementary nonplanar surfaces on the first shell and platen of the May pump as taught by Dorman and Jassawalla et al would be obvious to one of ordinary skill in the art in view of the recognition that such, at the very least, would promote more complete expelling of the medical fluids in the bag of May which is cost efficient and the desire of May to cost efficiently expel fluids. In regard to claim 17, while the May reference does not clearly state that the shells are generally circular in outer shape, see Figures and col. 4, lines 57-63. Therefore, even if the May reference is not already expressly circular in outer shape, it certainly suggests to one of ordinary skill in the art that could be the case. Therefore to make the pump shell components of generally circular outer shape, if not already, would be obvious to one of ordinary skill in the art in view of the recognition that such would be more securely attachable to an annular ring and the desire of May for the shell components to have such capability.

17. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686

Art Unit: 3761

F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

18. Claims 14-17, 19 and 23-24 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4 of U.S. Patent No. 5,911,716. Although the conflicting claims are not identical, they are not patentably distinct from each other because since the instant application was filed later than the patent, the one way *In re Vogel* test applies, i.e. are the claims of the application obvious in view of the patent claims? In regard to claims 14-15, 19 and 23-24, these claims are generic or broader than the claims in the patent. Note the species of Figures 1-4 in the instant application and the patent, the election requirement of Paper No. 6 in the instant application, especially the listing of generic claims and Applicant's response in Paper No. 7 agreeing that such claims are generic to Figures 1-4. The claims in the patent are for a species or more specific embodiment. Once Applicants have received a patent for a species or more specific embodiment, they are not entitled to a patent for the generic or broader invention because the more specific "anticipates" the broader, see *In re*

Art Unit: 3761

Goodman, supra. The patented claims anticipate the application claims. In regard to claim 17, see, e.g., claim 1, line 8 and col.5, line 50-51 of the patent. Therefore, in regard to claims 16 and 17, the rationale with regard to claims 14-15, 19 and 23-24 also applies.

19. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The other references show other devices with nonplanar complementary surfaces.

Applicant's related patents and published applications are also made of record.

20. Any inquiry concerning this communication should be directed to K. Reichle at telephone number 703-308-2617.

KMR

January 23, 2003

*K. M. Reichle*  
KATH REICHEL  
PATENT EXAMINER